66 Claim 31 (new). The system of claim 28 wherein said second filter is a 3 micron collection filter.

REMARKS

This application has been carefully reviewed in light of the Office Action dated November 6, 2002. By way of this amendment, claim 29 has been canceled, and claims 6, 19, 21-23, 25, and 30 have been amended. New claim 31 has been added. Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached paper is captioned "VERSION WITH MARKINGS TO SHOW CHANGES MADE." Claims 1-28, 30, and 31 are currently pending in the application. Applicant hereby requests further examination and reconsideration in view of the following remarks.

Claims 1-20 and 25-30 have been rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. This rejection is respectfully traversed.

Specifically, regarding claims 1 and 12, the Examiner has stated that it appears that the method of weighing the filter is one of the most important aspects of the invention, and that, if it is, then it is imperative that the applicants describe how the filter is weighed in the system as shown in Figures 1-3.

Applicant submits that the relative importance of a particular claim element is not relevant to enablement. The test for enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation, per

MPEP §2164.01 (citing *United States v. Telectronics, Inc.*, 8 USPQ2d 1217 (Fed. Cir. 1988)).

Applicant further submits that weighing an object is such a fundamentally understood process that further description of how the filter is weighted is not required. One reasonably skilled in the art would simply know how to weigh the filter. For example, this may be performed by removing the filter from the system and manually weighing it on a scale or other weighing device. Furthermore, the specification describes at page 7, lines 21-22 that in general, the predetermined amount of contaminants is in the range of 70-90 milligrams. Using this information, one skilled in the art could easily determine which of any of a number of commonly available weighing devices would be appropriate for the weighing process, without undue experimentation.

It is also possible, as the Examiner has pointed out, that the filter could somehow be automatically weighed while still installed in the system. Applicant concedes that there is no description in the specification of how automatic weighing would be incorporated into the described system. However, this is moot, because each of the rejected claims is a method claim which does not recite an automatic weighing process.

In view of the above, it is submitted that the specific weighing method used need not be shown in the drawings or described in the specification because one skilled in the art would be able to determine the weight of a filter without undue experimentation. This is consistent with the standard set forth in MPEP §2164.05(a), which states that "the specification need not disclose what is well-known to those skilled in the art and preferably omits that which is well-known and already available to the public."

Applicant notes that the Examiner has stated, in reference to a manual weighing process, that "this practice is common knowledge and it would be obvious to a person of ordinary skill in the art to perform such steps for the weight

determination." If this statement is intended to mean that the claims are obvious, Applicant submits that, contrary to this assertion, even if the manner for carrying out one step in particular (i.e. the manual weighing step) is well known, the claim as a whole is not necessarily obvious.

The Examiner has also raised several §112, first paragraph issues with claims 4, 6, 13, 14, and 25. Applicant will address these points individually.

First, the apparatus shown in Figure 1 need not be combined with the system shown in Figure 2 "to operate the lubricant and the solvent separately in one system." The term "system" is used in the specification and claims broadly. The quoted language from the specification is only intended to point out that Figures 1 and 2 both illustrate a portion of the overall apparatus used to perform the claimed method. The two groups of components are clearly referred to as a "primary system" 10 and an "ancillary system" 28 (see page 5, lines 2-11), and the way in which the two interact is described in the same paragraph. The claims do not require that the two systems be connected or physically combined.

Second, the Examiner is correct that in a preferred embodiment, the filter 20 is physically taken out of the system as shown in Figure 1 and soaked in the solvent 32 that is contained in the tank 30 depicted in Figure 2. As pointed out above, the term "system" is used broadly in the claims, and there is no requirement that the apparatus of Figure 2 be somehow connected to or physically combined with the apparatus of Figure 1.

Third, the second solvent is not explicitly shown in the drawings because of the procedure by which it is employed. The second solvent is passed through the ancillary system 28 of Figure 2 after the first solvent is passed through, using the same procedure and apparatus as for the first solvent. During this procedure, the second solvent is placed into the same tank 30 that the first solvent had previously occupied. This procedure is clearly described at page 6, lines 8-18 of the specification.

Fourth, claim 6 specifically recites the step of "flushing said oil-based fluid through a preliminary filter prior to flushing said oil-based fluid through said gearbox". It is noted that the term - - preliminary - - has been substituted for the term "another" in claim 6 to more clearly identify which filter is being referenced. The purpose of the preliminary filter and of this method step is to remove any contaminants from the oil-based flushing fluid before it enters the gearbox. That way, the risk that additional contaminants be introduced by the flushing procedure is reduced. This procedure and the apparatus for implementing the preliminary filter are clearly described at page 3, line 17, through page 4, line 3 of the specification. The recited preliminary filter 19 is clearly shown in Figure 1, disposed between the pump 24 and the gearbox 12.

For the above reasons, it is submitted that each of the claims 1-20 and 25-30 is fully supported by the original specification and would enable one skilled in the art to practice the invention without undue experimentation. Accordingly, it is requested that the rejections be withdrawn.

Claims 21 and 22 have been rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent 6,457,564 (Damm et al.) this rejection is respectfully traversed in light of the present amendment.

Claim 21 has been amended to recite that the clean check system includes the element of a preliminary filter fluidly connected between the source of an oil-based fluid and the gearbox inlet.

Damm et al. is directed to a combination lubrication system for an internal combustion engine and a associated gearbox and discloses (see Figure 1) a gear device (gearbox) 3 having a lubricant supply L which is pumped to the sump 5 of an internal combustion engine 2 by a pump 18. The lubricant flows through a filter 24 after passing through the pump 18.

Damm clearly does not show a system which has both a first filter fluidly connected to an gearbox outlet and a preliminary filter fluidly connected between

the source of an oil-based fluid and the gearbox inlet, as recited by the amended claim. This is an important difference because, as discussed above, the addition of the preliminary filter reduces the chances of introducing contaminants into the gearbox during the flushing procedure. Furthermore, the system of Damm et al. is not a system for performing a clean check on a gearbox, but rather a working combination of an internal combustion engine and an associated gearbox. The purpose of the present invention is to ensure that a gearbox is sufficiently free of potentially damaging contaminants before being assembled into such a working combination, and one skilled in the art would not use the working combination of Damm et al. to perform the claimed clean check method.

Accordingly, it is submitted that Damm et al. fails to disclose every element of amended independent claim 21 and the rejection should be withdrawn.

Claim 22 depends from independent claim 21 and is thus believed to be allowable for the reasons set forth above.

Claims 23 and 24 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Damm et al. This rejection is respectfully traversed in light of the present amendment.

The Examiner has stated that a selection of a known material based on its suitability for the intended use is well known in the art and is generally recognized as being within the level of ordinary skill in the art. However, at most this would teach one skilled in the art to select the particular materials claimed. This modification does not cure the failure of Damm et al. to teach every element of amended claim 21, from which claims 23 and 24 depend, as discussed above. Accordingly, it is submitted that the rejection should be withdrawn.

In addition to the above-noted amendments to claims 6 and 21, claims 19, 22, 23, 25, and 30 have been amended to more clearly identify the various filters recited therein. No new matter is contained therein.

Applicant has chosen to add new dependent claim 31. No new matter is contained therein. It is submitted that the prior art of record does not disclose or suggest this new claim.

In view of the above, it is submitted that the claims are in condition for allowance. Reconsideration of the objections and rejections is requested. Allowance of claims 1-28, 30, and 31 at an early date is solicited.

Respectfully submitted,

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Date

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Claims 6, 19, 21-23, 25, and 30 have been amended as follows:

Claim 6 (amended). The method of claim 1 further comprising the step of flushing said oil-based fluid through a preliminary [another filter] prior to flushing said oil-based fluid through said gearbox.

Claim 19 (amended). The method of claim 12 further comprising the step of flushing said oil-based fluid through a preliminary [another] filter prior to flushing said oil-based fluid through said gearbox.

Claim 21 (amended). A system for performing a clean check on a gearbox having an inlet and an outlet, said system comprising:

a source of an oil-based fluid fluidly connected to said gearbox inlet;

a first filter fluidly connected to said gearbox outlet;

a preliminary filter fluidly connected between said source of an oil-based fluid and said gearbox inlet; and

means for causing said oil-based fluid to flow through said gearbox, said preliminary filter, and said first filter.

Claim 22 (amended). The system of claim 21 wherein said means for causing said oil-based fluid to flow through said gearbox and said first filter is a pump.

Claim 23 (amended). The system of claim 21 wherein said first filter is a 3 micron collection filter.

Claim 25 (amended). The system of claim 21 further comprising means for soaking said first filter in a solvent.

Claim 30 (amended). The system of claim 21 [29] wherein said preliminary [second] filter is a 3 micron collection filter.